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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/059,562

04/14/1998

TOSHIMITSU KONUMA

0756-1790

8686

31780

7590

12/22/2003

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EXAMINER

NGUYEN, DUNG T

ART UNIT

PAPER NUMBER

2871

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/059,562

Applicant(s)

KONUMA ET AL.

Examiner

Dung Nguyen

Art Unit

2871

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-33, 38, 39, 49-51, 55-58, 65-67, 83-94, 99, 106-110 and 115-135 is/are pending in the application.

4a) Of the above claim(s) 38, 39, 83-94, 99, 106-108, 116-119, 122, 123 and 128-132 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33, 49-51, 55-58, 65-67, 69, 109-110, 115, 120-121, 124-127, 133-135 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicants' amendment dated 09/23/2003 has been received and entered.

By the amendment, claims 31-33, 49-51, 55-58, 65-67, 69, 109-110, 115, 120-121, 124-127 and 133-135 are now pending in claims.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 67 and 69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuboyama, US Patent No. 4,796,979, in view of Tsuboyama et al., US Patent No. 4,775,225, as state in the previous office action dated 05/21/2003.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 31-33, 49-51, 55-58, 65-67, 69, 109-110, 115, 120-121, 124-127 and 133-135 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 17-19 of U.S. Patent No. 5,594,569 as stated in the previous office action.

Remarks

5. Regarding claims 38-39 and 83-94, those claims are withdrawn from consideration as being directed to canceled claims 35-36 and 71-74, respectively.

6. Applicant's arguments filed 09/23/2003 have been fully considered but they are not persuasive:

Applicants' argument are as follows:

. IDS: Examiner inadvertently overlooked the citation of the Chandani et al. article. (paper 14 filed 04/14/1998). Copending application 09/781,154 has not consideration as prior art (paper 26 filed 01/25/2000)

. 103 rejection: Tsuboyama '979, Tsuboyama '225 and Yamamoto do not teach a resin disposed between substrate and a spacer disposed between the substrate. Specially, spacer 108 in Tsuboyama '225 cannot be relied upon to teach both a resin disposed between substrates, and a spacer disposed between the substrates.

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. Double Patenting: the '569 patent fails to recite that a portion of the resin is contiguous to the orientation film and to the film provided over the second substrate. And the resin has a column shape.

Examiner's responses to Applicants' argument:

. IDS: with respect to the IDS filed 04/14/1998 and 01/25/2000, the Examiner will reconsideration such papers when they are all located in file.

. 103 rejection: Regarding claim 66 and 67, the Examiner respectfully disagrees with the applicant's viewpoint. In particular, it is noted that the features upon which applicant relies (i.e., a spacer and a resin that is contiguous to an orientation film on one substrate and to a film provided over another substrate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

. Double Patenting: the Examiner, again, respectfully disagrees with the applicant's viewpoint and respectfully invited the applicants to review the '569 patent (figure 1, claims 3 and accompanying text) in which Konuma et al. '569 clearly disclose a resin with a column shape as claimed invention. Accordingly the double patenting rejection stand.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period, for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Nguyen whose telephone number is 703-305-0423. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 703-305-3492. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

DN
12/15/2003



Dung Nguyen
Patent Examiner
Art Unit 2871